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First Named Inventor	Erik J. Snapper
Art Unit	2176
Examiner Name	William L. Bashore
Attorney Docket Number	003797.77746

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ENCLOSURES *(check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
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  - ☒ After Final
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Firm *or* Individual name	Ross A. Dannenberg, Reg. No. 49,024
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Date	January 28, 2004

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#16

In re Application of: Erik J. SNAPPER et al.)
) Group Art Unit: 2176
Serial Number: 09/388,351)
) Examiner: William L. Bashore
Filed: September 1, 1999)
) Attorney Docket No. 003797.77746
For: SYSTEM AND METHOD FOR)
POPULATING FORMS WITH)
PREVIOUSLY USED DATA VALUES)

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Office Action of November 28, 2003 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 3-28 and 31-55 remain pending.

Claims 3, 6-7, 9-15, 21-22, 24, 26-28, 31, 33-34, 36-44, 46-47, and 50-54 stand rejected under § 103(a) as being unpatentable over Kikinis (U.S. Patent 5,794,259) in view of Light et al. (U.S. Patent 6,192,380) (hereinafter Light). This rejection is respectfully traversed.

Claim 3 recites, *inter alia*, "detecting a user-initiated action and inhibiting the copying of the suggested data value into the data entry region until after receipt of the user-initiated action." The Office Action states that Kikinis discloses "any one of a variety of mechanisms might be incorporated for selection of a highlighted item in the list..." However, the "highlighted item in the list" disclosed by Kikinis is a name tag and not a suggested data value, as recited in claim 3. Col. 4, ll. 7-10. Therefore, claim 3 is allowable for this reason.

Also, Kikinis does not teach or suggest inhibiting the copying of the suggested data value into the data entry region until after receipt of the user-initiated action. For example, Kikinis, at col. 3, line 66 – col. 4, line 4, indicates that Kikinis "fills all of the fields for which a match is made." While Kikinis, at col. 3, lines 63-66, implies waiting for a user-initiated action prior to filling in the form, Kikinis does not inhibit activity prior to the user-initiation action, as is recited

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in the claim. In fact, the present invention addresses a security concern discovered as a result of previous inadequate solutions such as is found in Kikinis. Specifically, as discussed in the present application at p. 11, lines 9-22, and p. 13, lines 19-24, malicious web sites may attempt to execute a script which *mimics* user input. By mimicking user input, the malicious web site prompts the system of Kikinis to fill in form fields and thus provide otherwise personal and/or confidential information (e.g., stored credit card numbers, passwords, etc.) to the malicious web site. It is specifically this security concern that the present invention addresses by inhibiting the copying of the suggested data value into the data entry region until after receipt of the user-initiated action, which is not taught or suggested by Kikinis.

In addition, claim 3 recites, *inter alia*, "comparing the field identifier of the selected field to previously stored field identifiers and, upon finding a match, displaying a list of suggested data values previously stored in response to one or more different forms previously filled in by the user..." However, neither Kikinis nor Light teaches or even suggests, upon finding a match, displaying a list of suggested data values previously stored. Kikinis teaches matching field names in the form with tags to the prestored information about the user and filling in all of the fields for which a match is made. Col. 3, line 66-Col. 4, line 1. Therefore, Kikinis does not show listing data values, much less suggested data values. In Kikinis, the various user information such as name, address, and/or home phone number is associated with a name tag. Col. 3, ll. 58-63. These name tags represent a category or group of data values, such as e-mail address or facsimile number. Col. 3, ll. 58-63; see also Fig. 2. However, claim 3 recites listing the actual suggested data values (i.e. name, address, home phone number), and not the group or category as is the nature of the tags described in Kikinis. See Specification, p. 10, ll. 14-20.

The Office Action further suggests that the name tags, as a collection of data values, are analogous to the data values themselves. Office Action, ¶ 18. However, selection and displaying the tags involves an understanding by the user of what exactly he or she is selecting. That is, the user must guess as to what will be input into the form. By only displaying the name of the category or collection of data values, the user is aware of only the categorical representation and not the actual data value that may be selected. In addition, the notion that displaying a collection tag is synonymous with or even similar to displaying the actual data value is misplaced and is without support. The actual data value provides the user with a more specific

understanding of the displayed/suggested data value than that which a broad category tag may offer.

Furthermore, two different data values corresponding to the same field may exist in a single category. In such an instance, the difference between displaying the category tag versus the actual data values becomes much more evident. By listing the data values, the user is aware of all available values. However, with only name tags as a reference, the user may be completely unaware of multiple matching values within a certain name tag, or of spelling variations of multiple suggested values. Kikinis requires two additional steps if the user subsequently learns that the tag corresponded to the wrong value, i.e., the user must delete the incorrect value and then retype the correct one. Therefore, the selection and display of suggested data values is entirely different from the selection and display of categorical name tags. As such, claim 3 is allowable for at least this reason.

Claims 4, 6, 9, 11-15, 21, 31, 33, 36, 38-44, 46, 52, 54, as with claim 3, recite, *inter alia*, "displaying a list of suggested data values previously stored in response to one or more different forms previously filled in by the user..." These claims are thus allowable for reasons similar to those for claim 3.

Claim 7 is dependent on claim 6, and thus is allowable for at least the reasons given above for claim 6.

Claim 10 is dependent on claim 9, and thus is allowable for at least the reasons given above for claim 6.

Claim 13 also recites, *inter alia*, "detecting a password field and, upon detection of such a field, forcing the user to select whether a data value for that field will be saved for later use." The Office Action states that notice is taken of HTML 4.0 and its form element attribute for specifying a password field so that password characters would be masked when typed into a form field and displayed. However, merely masking characters typed into a field is not that same as or similar to forcing the user to select whether the data value will be saved. The referenced HTML 4.0 technology is not relevant to saving or not saving password data values nor is it relevant to forcing the user to make that choice. Furthermore, the Office Action states that one of ordinary skill in the art would have recognized the problem of users not wanting to save a password in a place where it might be accessible for use by other users. However, being

cognizant of a particular problem does not make a particular solution obvious. Thus, claim 13 is allowable for this additional reason.

Claim 14 also recites, *inter alia*, "performing numerical processing on the field to determine whether the field represents a credit card number and, in response thereto, suppressing suggestions." The Office Action admits that Kikinis does not teach such a limitation but takes notice of HTML 4.0 which provides a form element attribute for specifying a password field so that password characters would be masked when typed into a form field and displayed. However, the HTML 4.0 technology does not teach or even suggest performing numerical processing on a field to determine whether the field represents a credit card number, as recited by claim 14. Additionally, masking credit card numbers is not at all similar to suppressing suggestions, as recited by claim 14. As such, claim 14 is allowable for these additional reasons.

Claims 22, 25, 26-28 are dependent on claim 21 and are thus allowable for at least the same reasons as given above for claim 21.

Claims 33 and 34 are dependent on claim 31 and are thus allowable for at least the same reasons as given above for claim 31.

Claim 37 is dependent on claim 36 and is thus allowable for at least the same reasons as given above for claim 36.

Claim 46 also recites, *inter alia*, "detecting that the one selected field is a password field and, in response thereto, determining whether the user has previously indicated whether a password should be stored for a URL on which the form resides and, if no such previous indication was made, prompting the user to indicate whether the password field should be stored for that URL." The Office Action states that Kikinis does not teach such a limitation and does not indicate Light teaches it. Thus, all of the claim limitations are not taught or suggested by the reference(s). Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, claim 46 is allowable for this reason as well.

Claim 47 is dependent on claim 46 and is thus allowable for at least the same reasons as given above for claim 46.

Claim 51 is dependent on claim 50 and is thus allowable for at least the same reasons as given above for claim 50.

Claim 53 is dependent on claim 52 and is thus allowable for at least the same reasons as given above for claim 52.

Claim 54 also recites, *inter alia*, "detecting that the one selected field is a password field and, in response thereto, determining whether the user has previously indicated whether a password should be stored for a URL on which the form resides and, if no such previous indication was made, prompting the user to indicate whether the password field should be stored for that URL." The Office Action states that Kikinis does not teach such a limitation and does not indicate Light teaches it. Thus, all of the claim limitations are not taught or suggested by the reference(s). Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, Claim 54 is allowable for this reason as well.

Claim 5, 23, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kikinis in view of Light and further in view of Gupta et al. (U.S. Patent 6,199,079) (hereinafter Gupta). Applicants respectfully traverse this rejection for at least the following reasons.

Claims 5 and 32, as with claim 3, recite, *inter alia*, "displaying a list of suggested data values previously stored in response to one or more different forms previously filled in by the user; in response to the user selecting one of the suggested data values, copying the data value selected by the user into the data entry region of the selected field." Claim 5 and 32 are thus allowable for reasons similar to those given for claim 3.

Claim 23 is dependent on claim 21 and is thus allowable for at least the reasons for Claim 21.

Claims 8, 25, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kikinis in view of Light as applied to claims 7, 21, and 33, respectively, above, and further in view of applicants' specification.

Claims 8, 25, and 35 are allowable based on the allowability of their respective base claims. In addition, claims 8, 25, and 35 recite, *inter alia*, "comparing the field identifier of the selected field to field identifiers in a statically created standard vCard schema, wherein the field identifiers in the vCard schema are mapped to one or more field identifiers in the common names data store." The Office Action states that Kikinis does not teach this claim limitation. Applicants disclose that the standard vCard schema was known in the art prior to the claimed

invention. However, there is no suggestion to combine the references. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)). In addition, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, *not in the applicant's disclosure.*" MPEP § 2143 (citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)) (emphasis added). Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, claims 8, 25, and 35 are allowable for this additional reason.

Claims 16-17, 19-20, 48-49, and 55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Light et al. in view of U.S. Patent No. 5,666,502 to Capps, issued September 9, 1997. Applicants respectfully traverse this rejection for at least the following reasons.

Claim 16 recites, *inter alia*, "detecting that one of the text fields on the second form is correlated with one of the text fields on the first form despite having a different field identifier and, in response thereto, retrieving a corresponding previously stored data value from the local storage area." The Office Action states that Light et al. teaches the claimed limitation. However, in Light et al., col. 6, lines 61-67, cited in the Office Action, the system is in a learning mode, where it first looks to see if the user entered a previously stored data value manually for a field identifier that has not already been stored in the database, and then updates the database to include the new field identifier. Thus, Light et al. does not first detect a correlation between field identifiers and then retrieve a previously stored data value from the local storage area in response thereto. Therefore, Light et al. does not teach or suggest the claimed limitation, and claim 16 is allowable. Claim 16 also recites, *inter alia*, "suggesting the data value retrieved in step (4) to the user as a possible value to be entered into the second form." Because Light et al. does not retrieve a data value from local storage as recited in the claim, discussed above, it cannot then suggest the data value to the user, even if suggested by Capps. There is no data value to suggest, as the user in Light et al. has already entered a data value manually. Thus, all of the claim limitations are not taught or suggested by the prior art references, and claim 16 is allowable for this reason as well.

Claims 17, 19, 20, 48, and 55 are dependent on claim 16 and are thus allowable for at least the same reasons as for claim 16.

In addition, claim 48, as with Claim 46 recites, *inter alia*, "detecting that one of the text fields on the second form is a username field and, in response to the user selecting a suggested username, automatically copying a password previously used in response to the selected username into a separate password field on the second form." Accordingly, claim 48 is also allowable for reasons similar to claim 46.

Claim 49 is dependent on claim 48 and is thus allowable for at least the same reasons as for claim 48. Claim 49, similar to claim 43, also recites, *inter alia*, "matching a URL associated with the second form to a previously stored URL and, in response to a match failure, inhibiting the copying of the password." Accordingly, claim 49 is also allowable for these reasons similar to those for claim 43.

Claim 55, as with claim 54, also recites, *inter alia*, "detecting that the one text field is a password field and, in response thereto, determining whether the user has previously indicated whether a password should be stored for a URL on which the form resides and, if no such previous indication was made, prompting the user to indicate whether the password field should be stored for that URL." Accordingly, claim 55 is also allowable for reasons similar to those for claim 54.

Claim 18 stands rejected under 35 U.S.C § 103(a) as unpatentable over Light et al. in view of Capps as applied to claim 16 above, and further in view of Applicants' specification. Applicants respectfully traverse this rejection for at least the following reasons.

Claim 18 depends on claim 16 and is allowable for at least similar reasons as for claim 16. Claim 18 also adds the step of using Bayesian inference techniques. The Office Action concedes that neither Light et al. not Capps teach using Bayesian inference techniques. Even if Bayesian techniques were known prior to the invention, there is no suggestion to combine or modify the references other than in Applicants' own disclosure. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01 (*citing In re Mills*, 916 F.2d 680 (Fed.Cir 1990)). In addition, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in

applicant's disclosure. MPEP § 2143 (citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)). Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, claim 18 is allowable.

Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kikinis in view of Light et al. and further in view of Capps. Applicants respectfully traverse this rejection for at least the following reasons.

Applicants respectfully submit that that there is no motivation or suggestion to combine Kikinis, which discloses a system for filling in fields on forms on the World Wide Web (WWW) by associating specific pre-stored data values with field names, with Capps, which discloses a data input technique for a proprietary, hand-held personal organizer. Kikinis describes a system that allows a user to link specific pre-stored data, usually data unique to the user, with fields in forms encountered on the Internet. *See* Kikinis, col 1, lines 45-50. By contrast, the personal organizer disclosed in Capps is not connected to the Internet, and only encounters forms provided by and under the control of the program code on the proprietary personal organizer itself. *See* Capps, figs. 13A and 13B, for example. Furthermore, the data values in Capps are not specific, pre-stored data values that are unique to the user. Capps instead manages data values that the user previously entered on proprietary forms, regardless of their uniqueness and specificity to the user.

In addition, claim 45 recites, *inter alia*, "wherein the computer-executable instructions permit the user to delete one of the previously stored suggested data values." The Office action states that neither Kikinis nor Capps teaches allowing the user to delete one of the previously stored suggested data values. A finding of obviousness is based on Capps teaching removing the least recently used item from a history list when the list has reached maximum size. Thus, even if the references were combined, all of the claim limitations are not taught or suggested by the combined references. Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, claim 45 is allowable for this reason as well.

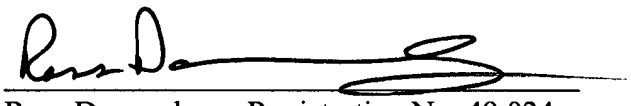
CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 28 day of January, 2004 By: 

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